

**REMARKS**

Claims 1-22 are pending.

Claims 1-22 are rejected.

This response is submitted in response to a final office action. The Applicants submit that the instant response places the application in a condition for allowance, or alternatively, in better form for appeal.

**CORRECTED DRAWING DISAPPROVAL**

Corrected Figure 1 is not approved. The Examiner stated that Figure 1, as now shown, includes reference numerals 19A and 19B that are allegedly directed to the same openings, as are reference numerals 20 and 22. The Examiner stated that in the first paragraph on page 4 of the Specification, reference numerals 20 and 22 designate the “at least one intake port 20, and may include a second port 22, for receiving fluid from the reservoir.” The Examiner stated that the two openings shown in Figure 1 couldn’t both be intake and outlet ports.

The Applicants respectfully traverse the Examiner’s disapproval of corrected Figure 1.

Initially, reference numerals 20 and 22 point **generally** to the pump receiving area that includes at least one intake port 20, and may include a second port 22 (*i.e., not necessarily another intake port*), for receiving fluid from the reservoir external to the pump **and pumping th fluid**. Conversely, reference numerals 19A and 19B point

***specifically*** to the area of the porting plate 19 (which in a preferred embodiment is a valve manifold cover) that provides intake or outlet porting holes, 19A and 19B, respectively, into the pumping chamber 17. These areas correspond roughly to the location of the worm trails 15 (which are configured to provide inlet and outlet porting). That is, the respective reference numerals, 19A, 19B, 20, and 22, respectively, are pointing to different areas and structures.

Accordingly, the Applicants submit that previously submitted corrected Figure 1 is proper and respectfully requests approval of the same by the Examiner.

### **35 USC §112, FIRST PARAGRAPH REJECTION**

Claims 1-22 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner asserted that claims 1-22 contain subject matter which was not described in the Specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Applicants respectfully traverse the 35 U.S.C. §112, first paragraph rejection of claims 1-22.

The Examiner appears to be under the misapprehension that both ports must be either intake ports or outlet ports, but cannot be either one. For example, a port can function either as an intake or an outlet, i.e., fluid can be transported into the port or from the port. Thus, by way of a non-limiting example, fluid can be pumped from one of

the worm trails 15, via port 19A, for example, and pumped into another adjacent worm trail 15, via port 19B, for example, and vice versa. See page 3, lines 14-22 of the Specification, which states:

In a preferred embodiment, pump mounting face is external of the pump and uses existing oil pan or transmission fixtures. This provides for the necessary amount of oil for the inlet without using extra space in the pump housing, therefore, using less space inside the oil pan or transmission. ***In a preferred embodiment, an existing valve manifold VM in a transmission has worm trails 15 configured to provide inlet and outlet porting. A porting plate 19 (which in a preferred embodiment is a valve manifold cover) is provided for providing intake or outlet porting holes, 19A and 19B, respectively, into the pumping chamber 17.*** Alternatively, the plate 19 and pump housing 12 could be integral with one another. (Emphasis added).

Accordingly, the Applicants submit that the 35 U.S.C. §112, first paragraph rejection of claims 1-22 has been overcome.

### **35 USC §103(a) REJECTION**

Claims 1-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,106,240 to Fischer et al. in view of U.S. Patent No. 4,185,717 to Ford, Jr. et al.

The Applicants respectfully traverse the 35 U.S.C. §103(a) rejection of claims 1-22.

The standard for obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the

desirability and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir.1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

The law is also clear that a claim in dependent form shall be construed to incorporate all the limitations of the claim to which it refers. 35 U.S.C. §112 ¶ 4.

The Examiner is correct that Fischer et al. do not disclose or suggest "at least one of said intake or exit port connecting to porting in a surface of a component to which the pump assembly is attached."

The Examiner apparently cited Ford, Jr. et al. to correct the deficiencies in the disclosure of Fischer et al.

However, Ford, Jr. et al. merely discloses that the porting 34, 36 is directly, and thus integrally, part of the non-submerged pump element, i.e., Ford, Jr. et al. does not

disclose or suggest a pumping chamber having an intake and an exit port therein for receiving fluid from a fluid reservoir and pumping fluid ***and*** at least one intake or exhaust port derived from porting configured in a surface adjacent to ***and not part of the pump***.

Thus, one of ordinary skill in the art would not look to either Fischer et al. and/or Ford, Jr. et al., either alone or in combination therewith, to construct a submerged pump, as presently claimed.

Accordingly, the Applicants submit that the 35 U.S.C. §103(a) rejection of claims 1-22 has been overcome.

### **CONCLUSION**

In view of the foregoing, the Applicant respectfully requests reconsideration and reexamination of the Application. The Applicant respectfully submits that each item raised by Examiner in the Final Office Action of August 28, 2003 has been successfully traversed, overcome or rendered moot by this response. The Applicant respectfully submits that each of the claims in this Application is in condition for allowance and such allowance is earnestly solicited.

The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Any needed extension of time is hereby requested with the filing of this document.

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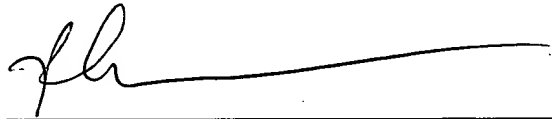
Docket No. DKT 01096  
(BWI-00073)

The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 501612. A duplicate copy of this letter is enclosed herewith for this purpose.

Respectfully submitted,

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